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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,499	07/16/2003	Masami Shirai	P23561	8848

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EXAMINER	
PRITCHETT, JOSHUA L	

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/619,499	SHIRAI ET AL.
	Examiner	Art Unit
	Joshua L. Pritchett	2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☒ Claim(s) *1-8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 July 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to Amendment filed January 20, 2006. Claim 1 has been amended as requested by the applicant.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the focusing of light to define the theoretical position as stated in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the newly added limitation defining the theoretical position is not present in the specification, claim language or drawings as originally filed. The new limitations have language relating to the position of optical elements when focusing light; however the drawings and the specification never show any relation between the theoretical position and the focusing of light on certain elements. The only reference to the theoretical position in the specification is on page 37, which says that the theoretical position is determined by the cam groove shown in Fig. 9. Fig. 9 shows nothing about how light is focused within the optical system.

Claims 2-8 depend from claim 1 and inherit the deficiencies thereof.

Claim Objections

Claims 1-8 are objected to because of the following informalities:

Regarding claim 1, claim 1 requires that the photographic optical system be to the object side of a theoretical position, and then defines the theoretical position as a position of the photographic optical system. According to the specification the "a theoretical position" is determined by the cam groove shown in Fig. 9 (this cam groove is the same as the dashed groove shown in Fig. 13). If the theoretical position is defined, as in the claim language, as a position of the photographic optical system is a certain situation the photographical optical system cannot always be on the object side of the theoretical position. Based on the applicant's specification, arguments and interviews if a person with perfect (20/20) vision were to focus the observation optical system on the reticle the theoretical position would be the same as the position of the photographic optical system. Fig. 13 illustrates that the theoretical position (dashed line for 75) is the same as the photographic optical system position (solid line for 75) at the top of the cam groove. The applicant claims that the photographing optical system must be to the object side (to the left in Fig. 13) of the theoretical position; however at the top portion of the cam grooves shown in Fig. 13 the theoretical position and the photographing optical system are at the same location.

Claims 2-8 depend from claim 1 and inherit the deficiencies thereof.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki (US 4,067,027) in view of Kobayashi (JP10-239735).

Regarding claim 1, Yamazaki teaches an observation device (Fig. 3) with a photographing function (col. 1 lines 5-10), having an observation optical system and a photographing optical system (col. 1 lines 5-10), the observation optical system being utilized as a focusing device for the photographing optical system (col. 2 lines 58-68), the observation optical system comprising, a first focusing mechanism that focuses the observation optical system so as to observe a close-range view through the observation optical system (col. 2 lines 58-68); a second focusing mechanism that focuses the photographing optical system so as to photograph as close-range view through the photographing optical system (col. 2 lines 58-68); an association mechanism that associates the first and second focusing mechanism with each other in such a manner that the observation optical system and the photographing optical system are always kept in a focused state (col. 2 lines 58-68; col. 3 lines 13-15); an objective (11) on which a reticle can be formed provided in the observation optical system with a predetermined dioptric power during an operation of the association mechanism (col. 2 lines 58-68). Based on the specification, drawings and newly amended claim language of the current invention, Yamazaki

teaches the same location relationship between the theoretical position and the photographic optical system for a person with perfect (ie. 20/20) vision or a person wearing corrective glasses or contact lenses. Yamazaki lacks specific reference to a reticle and the dioptric power difference between the eye and the ocular lens system and the objective lens system and the observation optical lens system being cancelled. It is extremely well known in the art to provide a reticle on an objective lens for the purpose of providing scale or targeting of an object viewed through the objective. Official Notice is taken. Kobayashi teaches correcting the cam of the moving lens to amend the diopter for the purpose of eliminating a difference between the dioptric powers (para. 0034; translation from the PAJ website). Kobayashi teaches the correction works for both close and far distances (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Yamazaki reference include a reticle as is known in the prior art for the purpose of providing scale or targeting of an object viewed through the objective. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the ocular lens system of the Yamazaki reference positioned so as to cancel the dioptric power difference as taught by Kobayashi for the purpose of allowing the user to see a clear image of the viewed object.

Regarding claim 2, Yamazaki teaches the invention as claimed but lacks specific reference to the use of an arithmetic mean to measure the dioptric power difference. It is extremely well known in the art to use an arithmetic mean to measure the dioptric power different between optical elements. Official Notice is taken. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Yamazaki

invention use an arithmetic mean to determine the dioptric power difference as is known in the art for the purpose of obtaining a reliable value for the dioptric power different.

Regarding claim 3, Yamazaki teaches the association mechanism comprises a rotary wheel member (14) having a manually operated rotary wheel; the observation optical system comprises two optical system elements that are movable along the optical axis of the observation optical system to focus the observation optical system (Fig. 3; col. 2 lines 58-68); the first focusing mechanism forms a first movement-conversion mechanism for converting a rotation movement of the rotary wheel member into a relative back and forth movement of the two optical system elements (col. 2 lines 58-68); the photographing optical system is movable relative to an imaging plane along the optical axis of the photographing optical system to focus the photographing optical system; and the second focusing mechanism forms a second movement conversion mechanism for converting a rotation movement of the rotary wheel member into a back and forth movement of the photographing optical system elements relative to the image plane (col. 2 lines 58-68).

Regarding claim 4, Yamazaki teaches the rotary wheel member comprises a rotary wheel cylinder in which a lens barrel is housed so as to be movable along the central axis of the rotary wheel cylinder (Fig. 3), the photographing optical system is housed in the lens barrel; the second movement conversion mechanism comprises a first cam groove formed in one of the rotary wheel cylinder and the lens barrel; and a first cam follower formed in the other of the rotary wheel cylinder and the lens barrel; and the first cam groove is formed in such a manner that a rotational movement of the rotary wheel cylinder is converted into a back and forth movement of the lens barrel along the central axis of the rotary wheel cylinder (Fig. 3; col. 2 lines 58-68).

Regarding claim 5, Yamazaki teaches the rotary wheel member comprises a rotary wheel cylinder in which a lens barrel is housed so as to be movable along the central axis of the rotary wheel cylinder (Fig. 3), the observation optical system is housed in the lens barrel; the first movement conversion mechanism comprises a second cam groove formed in one of the rotary wheel cylinder and the lens barrel; and a second cam follower formed in the other of the rotary wheel cylinder and the lens barrel; and the second cam groove is formed in such a manner that a rotational movement of the rotary wheel cylinder is converted into a back and forth movement of the lens barrel along the central axis of the rotary wheel cylinder (Fig. 3; col. 2 lines 58-68).

Regarding claim 6, Yamazaki teaches the observation optical system forms a pair, so that the observation optical device function as a binocular telescope with a photographing function (Fig. 3).

Regarding claim 7, Yamazaki teaches the pair of observation optical systems are mounted on an optical system mount plate that comprises a first and second plates that are movable relative to each other, one of the pair of observation optical systems is placed on the first plate and the other of the pair of optical systems is placed on the second plate, so that the distance between the optical axes of the pair of observation optical systems is adjusted by changing the relative positions of the first and second plates (Fig. 3; col. 2 lines 55-57).

Regarding claim 8, Yamazaki teaches the first and second plates are linearly moved relative to each other so that the optical axes of the pair of observation are moved in a predetermined plane, whereby the distance between the optical axes of the pair of observation optical systems is changed (col. 2 lines 55-57).

Response to Arguments

Applicant's arguments filed January 20, 2006 have been fully considered but they are not persuasive.

Applicant argues that one of ordinary skill in the art would recognize that the drawings originally filed with the application would show all the claimed limitations. The applicant then uses figures not part of the original disclosure to explain the how the claimed limitations function. The figures A, B and C are not part of the original disclosure and have not been added to the application through amendment, therefore the claimed limitations as discussed in the objection to the drawings above have not been shown in the drawings. Examiner would consider the addition of figures A, B, and C to be new matter not part of the original disclosure.

Applicant argues that the specification provides support for all of the claimed limitations. The specification only mentions the theoretical position a single time and defines the theoretical position as being determined by the cam groove 75 shown in Fig. 13. This minimal definition does not provide support for the claimed limitations relating to the theoretical position. Claim 1 states, "the theoretical position is defined as a position of said photographical optical system such that, when an image observed through said observation optical system is focused on said reticle, the image obtained by said photographic optical system is also focused." The examiner cannot determine how one of ordinary skill in the would interpret the theoretical position being determined by the cam groove 75 of Fig. 13 as including all the above quoted limitations.

Applicant further argues that the lower part of the cam groove 75 in Fig. 13 is offset form the lower part of the cam groove 75 of Fig. 9 (dotted line in Fig. 13). The term "lower part" does

not appear in the claim limitations and is also broad to the extent that the regions where the cam grooves overlap may read on such a claim limitation. Further the dioptric power difference cancellation is not limited to only the close-range viewing, therefore the objection is proper if the observer is viewing a distance object.

Applicant further argues that the prior art fails to teach a reticle. The use of a reticle is extremely well known in the art and one of ordinary skill in the art would incorporate a reticle for the purposes discussed in the rejection above.

Applicant further argues that the prior art fails to teach or suggest correction for an object observed in close-range view. The Kobayashi reference teaches that correction can be made for both far and close-range viewing (abstract). The claim does not require that the correction occur only in the close-range viewing, therefore the prior art teaches the invention as claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP

DREW A. DUNN
SUPERVISORY PATENT EXAMINER